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Alston & Bird LLP Bank of America Plaza 101 South Tryon Street Suite 4000 Charlotte, NC 28280-4000			BOVEJA, NAMRATA	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/635,292	<b>Applicant(s)</b> BRICE ET AL.	
	<b>Examiner</b> PINKY BOVEJA	<b>Art Unit</b> 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 June 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This office action is in response to the RCE communication filed on 06/05/2008.
2. Claims 1-38 are presented for examination.
3. Amendments to claims 1, 2, 4-7, 12, 13, 17, 20, 25, 30, and 35 have been entered and considered.

#### **Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*

4. Claims 1-38 are rejected under 35 U.S.C. 101.

*Claims 1-11 and 20-29 are rejected under 35 U.S.C. 101, because, based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)). A method and system claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fail to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing, since the claimed steps as recited can be performed mentally by a user.*

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*Specifically, the claims do not recite that the recited steps are being performed by using a computer.*

5. *Claims 12-38 are rejected under 35 U.S.C. 101, because the claims are directed to a non-statutory subject matter.*

*The claimed invention taken as a whole is directed to a mere computer program (a program listing), i.e., to only its description or expression. The claims are descriptive material per se and hence non-statutory. A computer program is merely a set of instructions capable of being executed by a computer; the computer program itself is not a process. A claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, is non-statutory functional descriptive material. The Applicant recites a processing element adapted to carry out various steps, however, a processing element from the claim seems to be software per se that carries out the various steps. While the specification on page 9 paragraph 19 states that the offer generating module may be a processing element which may be a computer system with processing components, this is not a specific definition, since a processing element may also be just software per se. The Applicant needs to specifically claim that the system comprises of a processor, memory, etc that can execute a program to carry out the recited steps. See MPEP § 2106 IV. B. 1. (a).*

**Claim Rejections - 35 USC § 112**

6. The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

- (A) the claims must set forth the subject matter that applicants regard as their invention; and
- (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

Claims 1-38 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-11 and 20-29 are rejected under 35 U.S.C. 112, second paragraph, *since the claims recite providing purchase offers associated with purchase options based upon a marketing criteria of a supplier that provides the purchase option and/or a seller that provides the one or more purchase offers. It is unclear from the claimed language what is the difference between a purchase option and a purchase offer. So, it is unclear what the Applicant is trying to claim here. It is interpreted to mean that the purchase option by the supplier is the price desired by the supplier and the purchase offers by the seller include the various purchase options provided by different suppliers. It is also unclear if providing one or more purchase offers in the dependent claims is referring to the same purchase offer that is provided in the independent claims. It is interpreted to mean that they are the same. Appropriate correction is required.*

7. Claims 12-19 and 30-38 are rejected under 35 U.S.C. 112, second paragraph, *since the claims recite a processing element adapted to carry out various steps. It is unclear from the claimed language if the steps are actually carried out, since adapted to*

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*does not necessarily mean that the steps are actually performed and rather indicates that the steps can be carried out. Furthermore, no weight needs to be given to steps performed by a processing element, since these steps are the intended use of the processing element. Appropriate correction is required.*

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-7, 11-17, 19-25, 27, 28, 30-35, 37, and 38 are rejected under 102(e) as being anticipated by Harford et al. (Patent Number 6,826,543 hereinafter Harford).

In reference to claims 1 and 20, Harford teaches a method for providing purchase offers, comprising: receiving, from a user, a purchase request including purchase profile information (abstract, col. 1 lines 52-62, col. 2 lines 26-31, col. 7 lines 55 to col. 8 lines 55, and col. 8 lines 62 to col. 9 lines 30); determining a set of purchase options based on the purchase profile information (col. 1 lines 14-26 and col. 10 lines 13-38); determining a point value for each purchase option based on characteristics associated with the respective purchase option (col. 12 lines 38 to col. 13 lines 62 and Figures 16-18); and limiting and providing one or more purchase offers associated with respective purchase options based upon the point values for the

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purchase options and further based upon a marketing criteria of a supplier that provides the purchase option or a seller that provides the one or more purchase offers, wherein the marketing criteria comprises at least one merchandizing rule that dictates a predetermined number of purchase offers provided to the user *and a format (i.e. user is shown the winning offer)* in which the purchase offers are provided to the user (col. 9 lines 31-44, col. 13 lines 23 to col. 14 lines 56, and Figure 12).

9. In reference to claims 2, 13, 21, and 31, Harford teaches the method and system wherein providing one or more purchase offers comprises limiting the purchase offers based upon the marketing criteria of the supplier and the seller (col. 13 lines 23 to col.

10. In reference to claims 3, 14, 22, and 32, Harford teaches the method and system wherein providing one or more purchase offers comprises presenting the purchase offers to the user in accordance with the marketing criteria of the supplier and the seller (col. 13 lines 23 to col. 14 lines 56).

11. In reference to claims 4, 17, 25, and 35, Harford teaches the method and system wherein monitoring comprises: monitoring purchase transactions associated with a type of purchase option offered by a supplier (col. 14 lines 26-56); and adjusting the providing of purchase offers for the type of purchase option offered by the supplier based on the monitoring (col. 10 lines 54-60 and col. 14 lines 26-56).

12. In reference to claim 5, Harford teaches the method, wherein adjusting the providing of purchase offers includes: adjusting a number of times the type of purchase option offered by the supplier is included in a document that presents the purchase offers based on the monitoring (col. 14 lines 26-56).

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13. In reference to claims 6, 15, 23, and 33 Harford teaches the method and system, wherein adjusting the *providing* of purchase offers includes: adjusting a location of a purchase offer associated with the type of purchase option offered by a supplier in a document that presents the purchase offers based on the monitoring (col. 14 lines 26-56).

14. In reference to claim 7, 16, 24, and 34, Harford teaches the method and system, wherein adjusting the *providing* of purchase offers includes: adjusting a format of a purchase offer associated with the type of purchase option offered by a supplier in a document that presents the purchase offers based on the monitoring (col. 14 lines 26-56).

15. In reference to claims 11, 19, 27, and 37, Harford teaches the method and system further comprising constructing a plurality of data structures with each data structure containing no more than a predefined number of purchase options for a respective supplier, and wherein providing one or more purchase offers comprises providing one or more purchase offers from among the purchase options contained within the plurality of data structures (col. 11 lines 36 to col. 12 lines 15).

16. In reference to claims 12 and 30, Harford teaches an offer generating module for providing purchase offers comprising: a processing element adapted to receive, from a user, a purchase request including purchase profile information, said processing element also adapted to determine a set of purchase options based on the purchase profile information, said processing element further adapted to determine a point value for each purchase option based on characteristics associated with the respective



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purchase option, and said processing element additionally adapted to provide one or more purchase offers associated with respective purchase options based upon the point values for the purchase options and further based upon a marketing criterion of at least one of a supplier that provides the purchase option and a seller that limits and provides the one or more purchase offers, *wherein the marketing criteria comprises at least one merchandizing rule that dictates a predetermined number of purchase offers provided to the user and a format (i.e. user is shown the winning offer) in which the purchase offers are provided to the user, and said processing element further adapted to monitor activities associated with the at least one purchase offer and provide at least one purchase offer based on a comparison of the monitored activities and the at least one quantifiable marketing goal, wherein the manner in which said processing element identifies and scores (i.e. determines the point value) the purchase options and provides the purchase offer is based upon the user, the purchase profile information, the seller or the supplier of the purchase offer* (abstract, col. 1 lines 14-26 and 52-62, col. 2 lines 26-31, col. 7 lines 55 to col. 8 lines 55 , col. 8 lines 62 to col. 9 lines 44, col. 10 lines 13-38, col. 12 lines 38 to col. 14 lines 56, and Figures 12 and 16-18).

17. In reference to claims 28 and 38, Harford teaches the method and system wherein identifying a set of purchase options comprises selecting at least one database of purchase options based upon at least one of the user and the purchase profile information, and subsequently searching the selected database to identify the set of purchase options (col. 9 lines 15-30 and col. 11 lines 1 to col. 12 lines 16).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 8-10, 18, 26, 29, and 36 are rejected under U.S.C. 103(a) as being unpatentable over Harford in view of the article titled "Frustrated Fliers Say Fair Fare A Gamble," by Susan Glaser, The Plain Dealer, June 5, 2000, pg. 1.A. (hereinafter Glaser).

In reference to claim 8, Harford teaches the method of providing purchase offers (col. 13 lines 23 to col. 14 lines 56) and determining a point value for each purchase option (col. 12 lines 38 to col. 13 lines 62 and Figures 16-18). Harford does not teach determining an initial value for each purchase option, and assessing a penalty for at least some purchase options based upon at least one of variations between the purchase profile information and the respective purchase option and availability of the respective purchase option. Glaser teaches determining an initial point value for each purchase option, and assessing a penalty for at least some purchase options based upon at least one of variations between the purchase profile information and the respective purchase option and availability of the respective purchase option (see at least page 1 paragraph 4, page 2 paragraph 25, and page 3 paragraphs 26 and 27). It would have been obvious to employ in Harford's method of providing purchasing offers

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the penalty assessment as taught by Glaser, since this would lead to providing more targeted purchasing options to the customers and would allow the customers to choose the appropriate product or service based on multiple types of criteria such as scheduling, pricing, inventory, and connections simultaneously.

19. In reference to claim 9, Harford teaches determining a point value for each purchase option (col. 12 lines 38 to col. 13 lines 62 and Figures 16-18). Harford teaches the method wherein the purchase option is for purchasable items such as hotel rooms (col. 10 lines 13-53 and Figures 17 and 18). Harford does not specifically teach the method wherein the purchase option is a flight option, and wherein determining a value for each purchase option includes: determining a value for the flight option, assessing a penalty to the point value based on at least one of: i) a departure displacement time for the flight option compared to a requested departure time included in the purchase request, ii) a connection service type associated with the flight option, and iii) an inventory class status associated with the flight option. Glaser teaches the method wherein the purchase option is a flight option, and wherein determining a value for each purchase option includes: determining a value for the flight option, assessing a penalty to the point value based on at least one of: i) a departure displacement time for the flight option compared to a requested departure time included in the purchase request (page 2 paragraph 25 and page 3 paragraph 26), ii) a connection service type associated with the flight option (page 3 paragraph 27), and iii) an inventory class status associated with the flight option. It would have been obvious to employ in Harford's method of providing purchasing offers the options relating to purchasing flights as

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taught by Glaser, since flight tickets are a type of product that a user purchases online similar to hotel room purchases as taught by Harford.

20. In reference to claim 10, Harford teaches the method wherein the purchase request comprises profile information (col. 9 lines 14-30 and col. 11 lines 1-10). Harford also teaches the method wherein the purchase option is for purchasable items such as hotel rooms (col. 10 lines 13-53 and Figures 17 and 18). Harford does not teach the method wherein the purchase request comprises a travel request including travel profile information, further comprising: identifying a plurality of candidate schedules based upon the travel request; determining availability of the plurality of candidate schedules; determining a price of at least those candidate schedules that are available, and wherein the value for each purchase option is determined for each of the candidate schedules that are available. Glaser teaches the method wherein the purchase request comprises a travel request including travel profile information, further comprising: identifying a plurality of candidate schedules based upon the travel request (page 2 paragraph 15); determining availability of the plurality of candidate schedules (page 2 paragraph 14); determining a price of at least those candidate schedules that are available (page 2 paragraphs 15 and 25 and page 3 paragraph 27), and wherein the value for each purchase option is determined for each of the candidate schedules that are available (page 2 paragraphs 15 and 25 and page 3 paragraph 27). It would have been obvious to employ in Harford's method of providing purchasing offers the options relating to purchasing flights as taught by Glaser, since flight tickets are a type of product that a user purchases online similar to hotel room reservations as taught by

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Harford, and a user would want to compare ticket prices before carrying out his purchase just like he would want to compare hotel rates before locking into a given hotel.

21. In reference to claims 18, 26, and 36, Harford teaches determining a point value for each purchase option (col. 12 lines 38 to col. 13 lines 62 and Figures 16-18).

Harford does not teach the determining a value for each purchase option by determining an initial value for each purchase option, and by assessing a penalty for at least some purchase options based upon at least one of variations between the purchase profile information and the respective purchase option and availability of the respective purchase option. Glaser teaches the determining a value for each purchase option by determining an initial value for each purchase option, and by assessing a penalty for at least some purchase options based upon at least one of variations between the purchase profile information and the respective purchase option and availability of the respective purchase option (page 2 paragraphs 15 and 22). It would have been obvious to employ in Harford's method of providing purchasing offers the options relating to purchasing flights as taught by Glaser, since flight tickets are a type of product that a user purchases online similar to hotel room purchases as taught by Harford, and a user would want to compare ticket prices before carrying out his purchase just like he would want to compare hotel room prices before locking into a given hotel.

22. In reference to claim 29, Harford teaches the method wherein the purchase request comprises profile information (col. 9 lines 14-30 and col. 11 lines 1-10). Harford teaches the method wherein the purchase option is for purchasable items such as hotel

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rooms (col. 10 lines 13-53 and Figures 17 and 18) and scoring hotel room options (col. 12 lines 23 to col. 13 lines 63). Harford does not teach the method wherein the purchase request comprises a travel request including travel profile information, further comprising: identifying a plurality of candidate schedules based upon the travel request; determining availability of the plurality of candidate schedules; determining a price of at least those candidate schedules that are available, and wherein the value for each purchase option is determined for each of the candidate schedules that are available. Glaser teaches the method wherein the purchase request comprises a travel request including travel profile information, further comprising: identifying a plurality of candidate schedules based upon the travel request (page 2 paragraph 15); determining availability of the plurality of candidate schedules (page 2 paragraph 14); determining a price of at least those candidate schedules that are available (page 2 paragraphs 15 and 25 and page 3 paragraph 27), and wherein the value for each purchase option is determined for each of the candidate schedules that are available (page 2 paragraphs 15 and 25 and page 3 paragraph 27). It would have been obvious to employ in Harford's method of providing purchasing offers the options relating to purchasing flights as taught by Glaser, since flight tickets are a type of product that a user purchases online similar to hotel room purchases as taught by Harford, and a user would want to compare ticket prices before carrying out his purchase just like he would want to compare hotel room offers before locking into a given hotel room.

### ***Response to Arguments***

23. Applicant's remarks/arguments filed on 06/05/2008 have been fully considered

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but are moot in view of the new ground(s) of rejection.

24. Amendments to the claims 1, 2, 4-7, 12, 13, 17, 20, 25, 30, and 35 have been entered and considered.

25. While the Applicant addressed the previously made rejections under 35 USC § 112 second paragraph, the amendments have lead to the introduction of various 35 USC § 101 and 35 USC § 112 second paragraph rejections as recited in the office action above.

26. Applicant argues that Harford does not teach any marketing rule that affects the format of the ranked hotels that are provided to the user. The Examiner respectfully disagrees with the Applicant, since Harford does teach showing the user the winning hotel as formatted for display to the user on a screen (col. 9 lines 31-44 and Figure 12). The Applicant should also note that his claims recite dictating a format and the rules in Harford dictate that the winning hotel be displayed to the user. Additionally, the Examiner would like to note that the Applicant's claims do not even recite actually displaying the results to the user. Also, the Applicant argues that Harford does not teach providing a ranked list to the user. Again, this limitation has never been claimed, so the Applicant is arguing what he has not claimed.

27. Applicant argues that Harford does not teach providing purchase offers based on the marketing criteria of the seller and supplier. The Examiner respectfully disagrees and would like to point the Applicant to col. 13 lines 23 to col. 14 lines 56 where it is indicated both the supplier's and the seller's marketing criteria is used to present the offer to the user.

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28. Applicant also argues that Harford does not teach monitoring purchase transactions and adjusting the providing of purchase offers. The Examiner respectfully disagrees and would like to point the Applicant to col. 14 lines 48-56 where it is indicated that purchase transactions are monitored and if a hotel is no longer available at a given rate, then that hotel is removed from the ranked list, and a newly highest ranking hotel is selected.

29. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central Fax Number** for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should



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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

/NAMRATA BOVEJA/

Examiner, Art Unit 3622